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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Anders et al.	:	Shah, Amee A.
	:	
Serial No.: 10/759,931	:	Group Art Unit: 3625
	:	
Filing Date: January 16, 2004	:	
	:	
Title: SYSTEMS AND METHODS	:	IBM Corporation
FOR CONFIGURABLE	:	Intellectual Property Law
ENTITLEMENT	:	11400 Burnet Road
MANAGEMENT	:	Austin, Texas 78758

APPEAL BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I. REAL PARTY IN INTEREST

The real party in interest is International Business Machines, Inc., which is the assignee of the entire right, title and interest in the above-identified patent application.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-25 are pending in the Application. Claims 26-49 were added and then withdrawn. Claims 1-25 stand rejected. Claims 1-25 are appealed.

IV. STATUS OF AMENDMENTS

Appellants have not submitted any amendments following receipt of the final office action with a mailing date of September 6, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1:

In one embodiment of the present invention, a method for entitlement management comprises the step of responsive to a request for a service, determining if a recipient identified in the request is entitled to the service. Specification, page 8, line 25 – page 9, line 4; Figure 4, steps 406, 408, 410. The method further comprises that if the recipient is entitled to the service, delivering the service, wherein the step of determining if the recipient is entitled to the service comprises: comparing a set of administrator-configurable package profile attributes values associated with a package of services containing the service with corresponding values for the recipient. Specification, page 9, lines 5-21; Specification, page 10, line 11 – page 11, line 3; Figure 4, step 412; Figure 5, step 507.

Independent Claim 10:

In one embodiment of the present invention, a computer program product embodied in a tangible storage medium, the program product comprising programming instructions for entitlement management, the programming instructions for responsive to a request for a service, determining if a recipient identified in the request is entitled to the service. Specification, page 8, line 25 – page 9, line 4; Specification, page 13, lines 1-20; Figure 4, steps 406, 408, 410. The program product further comprises programming instructions for if the recipient is entitled to the service, delivering the service, wherein the step of determining if the recipient is entitled to the service comprises: comparing a set of administrator-configurable package profile attributes values associated with a package of services containing the

service with corresponding values for the recipient. Specification, page 9, lines 5-21; Specification, page 10, line 11 – page 11, line 3; Specification, page 13, lines 1-20; Figure 4, step 412; Figure 5, step 507.

Independent Claim 19:

In one embodiment of the present invention, a data processing system for entitlement management comprises circuitry operable for, responsive to a request for a service, determining if a recipient identified in the request is entitled to the service. Specification, page 8, line 25 – page 9, line 4; Specification, page 12, line 16 – page 13, line 20; Figure 4, steps 406, 408, 410; Figure 8, elements 800, 814, 822. The data processing system further comprises if the recipient is entitled to the service, delivering the service, wherein the step of determining if the recipient is entitled to the service comprises: comparing a set of administrator-configurable package profile attributes values associated with a package of services containing the service with corresponding values for the recipient. Specification, page 9, lines 5-21; Specification, page 10, line 11 – page 11, line 3; Specification, page 12, line 16 – page 13, line 20; Figure 4, step 412; Figure 5, step 507; Figure 8, elements 800, 814, 822.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Claims 1-4, 6, 9-13, 15, 18-22 and 25 stand rejected under 35 U.S.C. §102(e) as being anticipated by Svancarek et al. (U.S. Patent Application Publication No. 2004/0039705) (hereinafter "Svancarek").

B. Claims 5, 8, 14, 17, 23 and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Svancarek in view of Talbot et al. (U.S. Patent Application Publication No. 2002/0116312) (hereinafter "Talbot").

C. Claims 7 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Svancarek.

VII. ARGUMENTA. Claims 1-4, 6, 9-13, 15, 18-22 and 25 are not properly rejected under 35 U.S.C. §102(e).

The Examiner has rejected claims 1-4, 6, 9-13, 15, 18-22 and 25 under 35 U.S.C. §102(e) as being anticipated Svancarek. Office Action (9/6/2006), page 7. Appellants respectfully traverse for at least the reasons stated below.

For a claim to be anticipated under 35 U.S.C. §102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. §2131.

1. Claims 1, 10 and 19 are not anticipated by Svancarek.

Appellants respectfully assert that Svancarek does not disclose "wherein said step of determining if said recipient is entitled to said service comprises: comparing a set of administrator-configurable package profile attributes values associated with a package of services containing said service with corresponding values for said recipient" as recited in claim 1 and similarly in claims 10 and 19. The Examiner cites paragraph [0034] of Svancarek as disclosing the above-cited claim limitation. Office Action (9/6/2006), page 8. Appellants respectfully traverse and assert that Svancarek instead discloses that upon collecting all appropriate information, the portal then sends such information to an eligibility service that determines whether the user is qualified to obtain/purchase the desired product key. [0034]. Further, Svancarek discloses that the eligibility service may employ most any business logic without departing from the spirit and scope of the present invention. [0034]. There is no language in the cited passage that discloses comparing a set of administrator-configurable package profile attributes values with corresponding values for the recipient. Neither is there any language in the cited passage that discloses comparing a set of administrator-configurable package profile attributes values associated with a package of services containing the service with corresponding values for the

recipient. Thus, Svancarek does not disclose all of the limitations of claims 1, 10 and 19, and thus Svancarek does not anticipate claims 1, 10 and 19. M.P.E.P. §2131.

Furthermore, as stated above, Svancarek discloses that upon collecting all appropriate information, the portal then sends such information to an eligibility service that determines whether the user is qualified to obtain/purchase the desired product key. This product key is different from a package of services. Appellants kindly direct the Board's attention to paragraph [0012] of Svancarek which indicates that the product key is used for activating a digital product/service. Further, Appellants kindly direct the Board's attention to paragraphs [0011, 0032, 0033 and 0035] which clearly indicate that a product key simply corresponds to a series of letters and digits that must be entered during software installation to authorize the user. Hence, the product key, as taught in Svancarek, does not correspond to a package of services.

In response to Appellants' above argument, the Examiner states:

Svancarek discloses determining eligibility by determining, for example, whether the customer is in a participating region and/or had a participating software product (page 4, ¶0034). The package profile attributes, as noted in the prior Office Action, are the geographic region and software product, which correspond to the examples of attributes cited by applicant in the Specification (page 7). In order to determine whether the geographic region is participating, a comparison must be made between the recipient value for region and the package profile value for participating region. The participating region is inherently administrator-configured. Therefore, Svancarek discloses comparing a set of administrator-configured attributes (i.e. the participating geographic region and/or software product) with corresponding values for the recipient in order to determine eligibility. Office Action (9/6/2006), page 3.

Appellants respectfully traverse. As stated above, Svancarek simply discloses that an eligibility service 28 determines whether the user is qualified to obtain/purchase the desired product key. [0034]. Svancarek additionally discloses that the eligibility service 28 may determine whether the customer is in a participating

region and/or has a participating software product. [0034]. Hence, Svancarek discloses determining if a user is qualified to obtain/purchase the desired product key based on if the customer is in a participating region.

There is no language in Svancarek that discloses comparing a set of administrator-configurable package profile attribute values. Svancarek simply discloses determining if the customer is in a participating region. How does the Examiner infer from this statement that Svancarek inherently discloses comparing a set of administrator-configurable package profile attribute values? As understood by Appellants, the Examiner appears to assert that Svancarek inherently discloses such a limitation. However, the Examiner must provide a basis in fact and/or technical reasoning to support the assertion that Svancarek inherently discloses comparing a set of administrator-configurable package profile attribute values. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that Svancarek inherently discloses comparing a set of administrator-configurable package profile attribute values, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). There is no language in Svancarek that would suggest such a procedure. The Examiner must provide evidence that the eligibility service 28 of Svancarek would compare a set of package profile attribute values. Since the Examiner has not provided any such objective evidence, the Examiner has not presented a *prima facie* case of anticipation for rejecting claims 1, 10 and 19. M.P.E.P. §2131.

Further, there is no language in the cited passage (paragraph [0034] of Svancarek) that discloses a set of package profile attribute values associated with a package of services. The Examiner has not specified where in the cited passage of Svancarek, Svancarek discloses a package of services which is associated with a set of package profile attribute values. Hence, Svancarek does not disclose all of the

limitations of claims 1, 10 and 19, and thus Svancarek does not anticipate claims 1, 10 and 19. M.P.E.P. §2131.

Neither it there any language the cited passage (paragraph [0034] of Svancarek) that discloses a set of package profile attribute values associated with a package of services containing the service with corresponding values for the recipient. The Examiner has not specified where in the cited passage of Svancarek, Svancarek discloses a package of services containing the services with corresponding values for the recipient. If the Examiner is referring to the product key, a product key is not a package of services as discussed above. Hence, Svancarek does not disclose all of the limitations of claims 1, 10 and 19, and thus Svancarek does not anticipate claims 1, 10 and 19. M.P.E.P. §2131.

2. Claims 2-4, 6, 9, 11-13, 15, 18, 20-22 and 25 are not anticipated by Svancarek for at least the reasons that claims 1, 10 and 19 are not anticipated by Svancarek.

Claims 2-4, 6 and 9 each recite combinations of features of independent claim 1 and hence claims 2-4, 6 and 9 are not anticipated by Svancarek for at least the above-stated reasons that claim 1 is not anticipated by Svancarek.

Claims 11-13, 15 and 18 each recite combinations of features of independent claim 10 and hence claims 11-13, 15 and 18 are not anticipated by Svancarek for at least the above-stated reasons that claim 10 is not anticipated by Svancarek.

Claims 20-22 and 25 each recite combinations of features of independent claim 19 and hence claims 20-22 and 25 are not anticipated by Svancarek for at least the above-stated reasons that claim 19 is not anticipated by Svancarek.

3. Claims 3, 12 and 21 are not anticipated by Svancarek.

Appellants respectfully assert that Svancarek does not disclose "configuring said set of package attributes wherein said set of package attributes includes selected

attributes having one or more attribute values" as recited in claim 3 and similarly in claims 12 and 21. The Examiner cites paragraphs [0034], [0036] and [0037] of Svancarek as disclosing the above-cited claim limitation. Office Action (9/6/2006), page 8. Appellants respectfully traverse and assert that Svancarek instead discloses that upon collecting all appropriate information, the portal then sends such information to an eligibility service that determines whether the user is qualified to obtain/purchase the desired product key. [0034]. Further, Svancarek discloses that the eligibility service may employ most any business logic without departing from the spirit and scope of the present invention. [0034]. In addition, Svancarek discloses that if the eligibility service determines that the customer is eligible to receive a product key for activating the software product at issue, then the eligibility service notifies the portal of same and also determines and identifies to the portal the proper type of product key to be distributed to the customer. [0036]. Additionally, Svancarek discloses that the portal redirects the customer to an appropriate location to obtain/purchase the required product key. [0037]. There is no language in the cited passages that discloses configuring a set of package attributes. Neither is there any language in the cited passages that discloses configuring a set of package attributes where the set of package attributes includes selected attributes having one or more attribute values. Thus, Svancarek does not disclose all of the limitations of claims 3, 12 and 21, and thus Svancarek does not anticipate claims 3, 12 and 21. M.P.E.P. §2131.

In response to Appellants' above argument, the Examiner appears to simply assert that it is inherent for Svancarek to configure the set of package attributes where the set of package attributes includes selected attributes having one or more attribute values. Office Action (9/6/2006), page 4. The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that Svancarek inherently discloses configuring the set of package attributes where the set of package attributes includes selected attributes having one or more attribute values. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide

extrinsic evidence that must make clear that Svancarek inherently discloses configuring the set of package attributes where the set of package attributes includes selected attributes having one or more attribute values, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Since the Examiner has not provided any such objective evidence, the Examiner has not presented a *prima facie* case of anticipation for rejecting claims 3, 12 and 21. M.P.E.P. §2131.

4. Claims 4, 13 and 22 are not anticipated by Svancarek.

Appellants respectfully assert that Svancarek does not disclose "if said service includes a limited number of accesses, decrementing a tracking count associated with the service." The Examiner cites paragraphs [0042] and [0043] of Svancarek as disclosing the above-cited claim limitation. Office Action (9/6/2006), pages 4 and 8. Appellants respectfully traverse and assert that Svancarek instead discloses that concomitant with the reporting service reporting the delivery of the product key to the database, such delivery is also reported to an activation database by the reporting service or by an intermediary between the databases. [0042]. In addition, Svancarek discloses that the activation database tracks each delivered product key with regard to whether same has already been employed to activate a corresponding software product on a particular computing device and if so pertinent activation information including an ID of such computing device. [0042]. Further, Svancarek discloses that the customer employs the delivered product key to activate the software product on a particular computing device by way of the product activation service and the activation database is updated to reflect that the product key has in fact been employed to activate the corresponding software product on the particular computing device as represented by the ID thereof. [0043]. Hence, Svancarek discloses updating the activation database to reflect that the product key has in fact been employed to activate the corresponding software product. However, there is no language in the cited passages that discloses that if the service includes a limited

number of accesses, then a tracking count associated with the service is decremented. Thus, Svancarek does not disclose all of the limitations of claims 4, 13 and 22, and thus Svancarek does not anticipate claims 4, 13 and 22. M.P.E.P. §2131.

In response to Appellants' above argument, the Examiner asserts that Svancarek's disclosure of updating the activation database to reflect that the product key has in fact been employed to activate the corresponding software product corresponds to the teaching of decrementing a tracking count associated with the service if the service includes a limited number of accesses. Office Action (9/6/2006), page 4. Appellants respectfully traverse. There is no language in Svancarek that discloses decrementing a tracking count. Neither is there any language in Svancarek that discloses keeping track of the number of accesses of software product 16 (as understood by Appellants, the Examiner asserts that software product 16 discloses the claimed service) as suggested by the Examiner. *Id.* Instead, Svancarek discloses keeping track of the number of additional product keys 14 distributed. [0035]. Hence, if Svancarek were to keep a tracking count, it would probably be keeping track of additional product keys 14 distributed and would most likely increment and not decrement a count as each additional product key 14 is distributed. Further, the claim limitation recites decrementing a tracking count associated with the service. As understood by Appellants, the Examiner asserts that software product 16 of Svancarek discloses the claimed service. There is no language in Svancarek that discloses decrementing a tracking count associated with software product 16. Thus, Svancarek does not disclose all of the limitations of claims 4, 13 and 22, and thus Svancarek does not anticipate claims 4, 13 and 22. M.P.E.P. §2131.

5. Claims 9, 18 and 25 are not anticipated by Svancarek.

Appellants respectfully assert that Svancarek does not disclose "logging a delivery of said service" as recited in claim 9 and similarly in claims 18 and 25. The Examiner cites paragraphs [0040]-[0042] of Svancarek as disclosing the above-cited

claim limitation. Office Action (9/6/2006), page 9. Appellants respectfully traverse and assert that Svancarek instead discloses that once the transaction is complete, the distributor reports the distribution of the product key to a reporting service. [0040]. Svancarek further discloses that the reporting service stores in the database a link between any information which was logged at the portal, allows the portal to discover such link when determining eligibility at a later time in connection with the copy of the software product, allows the provider to track the history of the copy of the software product and the distributed product keys therefor, and also can enforce any predefined business rules. [0041]. Additionally, Svancarek discloses that concomitant with the reporting service reporting the delivery of the product key to the database, such delivery is also reported to an activation database by the reporting service or by an intermediary between the databases. [0042]. In addition, Svancarek discloses that the activation database tracks each delivered product key with regard to whether same has already been employed to activate a corresponding software product on a particular computing device and if so pertinent activation information including an ID of such computing device. [0042]. However, there is no language in the cited passages that discloses logging a delivery of a service. Thus, Svancarek does not disclose all of the limitations of claims 9, 18 and 25.

In response to Appellants' above argument, the Examiner focuses on the language in paragraph [0041] of Svancarek that discloses that the reporting service 32 stores in the database 30 a link between any information that was logged at the portal 26, and allows the portal 26 to discover such a link when determining eligibility at a later time in connection with the copy of the software product 16, and allows the provider 20 to track the history of the copy of the software product 16 and the distributed product keys 14 therefor. Office Action (9/6/2006), page 5. The Examiner asserts that this language discloses the above-cited claim limitation. *Id.* However, there is no language in Svancarek that discloses that the information that was logged at the portal 26 corresponds to the delivery of the software product 16 (as understood by Appellants, the Examiner asserts that software product 16 corresponds

to the claimed service). Instead, Svancarek discloses that customer information is sent to the portal 26. [0032]. Further, Svancarek discloses that "information" corresponds to information that identifies the product for which a product key is required. Abstract. Hence, Svancarek does not disclose logging a delivery of the service.

Appellants further assert that Svancarek does not disclose "decrementing a number of available instances of said service if said service has a limited usage count" as recited in claim 9 and similarly in claims 18 and 25. The Examiner cites paragraph [0042] of Svancarek as disclosing the above-cited claim limitation. Office Action (9/6/2006), page 9. Appellants respectfully traverse and assert that Svancarek instead discloses that concomitant with the reporting service reporting the delivery of the product key to the database, such delivery is also reported to an activation database by the reporting service or by an intermediary between the databases. [0042]. In addition, Svancarek discloses that the activation database tracks each delivered product key with regard to whether same has already been employed to activate a corresponding software product on a particular computing device and if so pertinent activation information including an ID of such computing device. [0042]. There is no language in the cited passage that discloses decrementing a number of available instances of the service. Neither is there any language in the cited passage that discloses decrementing a number of available instances of the service if the service has a limited usage count. Thus, Svancarek does not disclose all of the limitations of claims 9, 18 and 25, and thus Svancarek does not anticipate claims 9, 18 and 25. M.P.E.P. §2131.

In response to Appellants' above argument, the Examiner focuses on language in paragraph [0035] of Svancarek which discloses that the eligibility service 28 may also determine by reference to a product key distribution database 30 whether the already-used product key 14 has previously resulted in the distribution of a set number of additional product keys 14. Office Action (9/6/2006), page 5. Hence,

Svancarek discloses determining whether the already-used product key 14 has previously resulted in the distribution of a set number of additional product keys 14. There is no language in the cited passage that discloses decrementing a number. Neither is there any language in the cited passage that discloses decrementing a number of available instances of the service. As understood by Appellants, the Examiner cites software product 16 as disclosing the claimed service. There is no language in the cited passage that discloses decrementing a number of available instances of software product 16. Neither is there any language in the cited passage that discloses decrementing a number of available instances of the service if the service has a limited usage count. Thus, Svancarek does not disclose all of the limitations of claims 9, 18 and 25, and thus Svancarek does not anticipate claims 9, 18 and 25. M.P.E.P. §2131.

- B. Claims 5, 8, 14, 17, 23 and 24 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Svancarek in view of Talbot.

The Examiner has rejected claims 5, 8, 14, 17, 23 and 24 under 35 U.S.C. §103(a) as being unpatentable over Svancarek in view of Talbot. Office Action (9/6/2006), page 10. Appellants respectfully traverse for at least the reasons stated below.

1. Svancarek and Talbot, taken singly or in combination, do not teach or suggest the following claim limitations.
 - a. Claims 5, 14 and 23 are patentable over Svancarek in view of Talbot.

Appellants respectfully assert that Svancarek and Talbot, taken singly or in combination, do not teach or suggest "wherein said substep of comparing a set of package profile attribute values associated with a package of services containing said service with corresponding values for said recipient comprises: for each profile attribute in said set of profile attributes, determining if a current attribute is single-valued; and if said current attribute is single-valued, determining said recipient is not

entitled if a value of said current attribute and a corresponding value for said recipient miscompare" as recited in claim 5 and similarly in claims 14 and 23. The Examiner cites paragraphs [0043]-[0044] of Talbot for teaching determining if a current attribute is single-valued. Office Action (9/6/2006), page 10. The Examiner further cites paragraph [0034] of Svancarek for teaching the remainder of the above-cited claim limitations. *Id.* Appellants respectfully traverse.

Svancarek instead teaches that upon collecting all appropriate information, the portal then sends such information to an eligibility service that determines whether the user is qualified to obtain/purchase the desired product key. [0034]. Further, Svancarek teaches that the eligibility service may employ most any business logic without departing from the spirit and scope of the present invention. [0034]. There is no language in the cited passage that teaches a set of profile attributes. Neither is there any language in the cited passage that teaches determining the recipient is not entitled if a value of the current attribute and a corresponding value for the recipient miscompare. Neither is there any language in the cited passage that teaches determining the recipient is not entitled if a value of the current attribute and a corresponding value for the recipient miscompare if the current attribute is single-valued. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 5, 14 and 23, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Further, Talbot instead teaches that if it is determined that any of the single value exclusions apply, the credit request is filtered out. [0043]. Talbot further teaches that if none of the single value exclusions apply, the credit request will be filtered by a second-pass filter involving multiple value factors. Talbot further teaches that if it is determined that any of the multiple value exclusions apply, the credit request is filtered out and will not be shown to that lender. [0044]. There is no language in the cited passages that teaches determining if a current attribute is single-

valued. Neither is there any language in the cited passages that teaches determining if a current attribute is single-valued for each profile attribute. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 5, 14 and 23, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

b. Claims 8, 17 and 24 are patentable over Svancarek in view of Talbot.

Appellants respectfully assert that Svancarek and Talbot taken singly or in combination, do not teach or suggest "wherein if said current attribute is not single-valued, determining said recipient is not entitled if each value of said current attribute and a corresponding value for said recipient miscompare" as recited in claim 8 and similarly in claims 17 and 24. As understood by Appellants, the Examiner cites paragraph [0034] of Svancarek as teaching the above-cited claim limitation. Office Action (9/6/2006), page 10. The Examiner previously cited paragraphs [0043]-[0044] of Talbot as teaching determining if the attribute value is single-valued or not. *Id.* However, this limitation is not recited in claims 8, 17 and 24. As a result, Appellants assume that the Examiner relies upon paragraph [0034] of Svancarek as teaching the entire above-cited claim limitation. Appellants respectfully traverse the assertion that Svancarek teaches the above-cited claim limitation.

Svancarek instead teaches that upon collecting all appropriate information, the portal then sends such information to an eligibility service that determines whether the user is qualified to obtain/purchase the desired product key. [0034]. There is no language in the cited passage that teaches determining the recipient is not entitled if each value of the current attribute and a corresponding value for the recipient miscompare. Neither is there any language in the cited passage that teaches where if the current attribute is not single-valued, determining the recipient is not entitled if each value of the current attribute and a corresponding value for the recipient miscompare. Therefore, the Examiner has not presented a *prima facie* case of

obviousness in rejecting claims 8, 17 and 24, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

2. Examiner's motivation for modifying Svancarek with Talbot to include the missing limitation of claims 5, 14 and 23 is insufficient to establish a *prima facie* case of obviousness.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Svancarek does not teach determining if a current attribute is single-valued, as recited in claim 5 and similarly in claims 14, and 23. Office Action (9/6/2006), page 10. The Examiner asserts that Talbot teaches the above-cited claim limitation. *Id.* The Examiner's motivation for modifying

Svancarek with Talbot to include the above-cited claim limitations is "to allow for a service provider to offer their services to those more likely to desire them or to those providers desire more by using provider-driven filtering criteria, as suggested by Talbot (page 2, ¶[0012]." *Id.* The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claims 5, 8, 14, 17, 23 and 24.

The Examiner' motivation ("to allow for a service provider to offer their services to those more likely to desire them or to those providers desire more by using provider-driven filtering criteria") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Svancarek to include the above-indicated missing claim limitation of claims 5, 14 and 23. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 5, 8, 14, 17, 23 and 24. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

As stated above, the Examiner cites paragraph [0012] of Talbot as support for the Examiner's motivation. Talbot teaches that borrowers get exposure to multiple lenders without having their credit reports reflect multiple inquiries (or "pulls"). [0012]. Talbot further teaches that the present invention enables "soft-pulls" and that the credit reports are masked, providing a degree of assurance that no discrimination based upon gender, address, age or the like is occurring in the lending process. [0012]. Hence, Talbot teaches ensuring that no discrimination occurs in the lending process by masking the credit reports. There is no language in Talbot (and in particular paragraph [0012]) that makes any suggestion for allowing for a service provider to offer their services to those more likely to desire them or to those providers desiring more by using provider-driven filtering criteria (Examiner's motivation). Neither is there any language in Talbot (and in particular paragraph [0012]) that suggests determining if a current attribute is single-valued (missing claim limitation of Svancarek) in order to allow for a service provider to offer their services to those more likely to desire them or to those providers desiring more by using

provider-driven filtering criteria (Examiner's motivation). The Examiner has simply cited to an arbitrary passage in Talbot that mentions some benefit caused by the invention of Talbot and then concludes that the Examiner has provided appropriate motivation. The Examiner has to provide some rationale connection between the cited passage that is the source of the motivation and the missing claim limitations. The Examiner's source of motivation (paragraph [0012] of Talbot) does not provide reasons as to why one skilled in the art would modify Svancarek to include the missing claim limitations of claims 5, 14 and 23. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 5, 8, 14, 17, 23 and 24. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Further, Svancarek addresses the problem of allowing the customer to obtain/purchase a product key in an automated manner from the developer of the software product or an agent thereof or the like. [0011]. The Examiner has not provided any reasons as to why one skilled in the art would modify Svancarek (which teaches allowing the customer to obtain/purchase a product key in an automated manner from the developer of the software product or an agent thereof or the like) to determine if a current attribute is single-valued (missing claim limitation). The Examiner's motivation ("to allow for a service provider to offer their services to those more likely to desire them or to those providers desire more by using provider-driven filtering criteria") does not provide such reasoning.

Why would the reason to modify Svancarek (whose purpose is to allow the customer to obtain/purchase a product key in an automated manner from the developer of the software product or an agent thereof or the like) to determine if a current attribute is single-valued (missing claim limitation) be to allow for a service provider to offer their services to those more likely to desire them or to those providers desire more by using provider-driven filtering criteria? Svancarek is not concerned with allowing for a service provider to offer their services to those more likely to desire them or to those providers desiring more by using provider-driven

filtering criteria. The Examiner cannot completely ignore the teachings of Svancarek in concluding it would have been obvious to modify Svancarek to include the missing claim limitation of claims 5, 14 and 23.¹ Further, what is the rationale connection between the Examiner's motivation and the missing claim limitation? Hence, the Examiner's motivation does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Svancarek to include the missing claim limitation of claims 5, 14 and 23. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 5, 8, 14, 17, 23 and 24. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

3. Examiner relies on a reference under 35 U.S.C. §103 that is not analogous prior art.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. M.P.E.P. §2143.01. In order to rely on a reference as a basis for rejection under 35 U.S.C.

¹ Appellants respectfully request Examiner Shah to respond to the following example. For example, suppose that the invention of a super soaker gun (essentially a plastic gun that shoots water) was never developed and an Applicant filed for a patent application on the super soaker gun. Applicant claims a plastic gun with a container of water that shoots water. The Examiner cites a primary reference that teaches a plastic gun that shoots darts and cites a secondary reference that teaches a plastic toy that contains a container of water. Since the primary reference does not teach a container filled with water, the Examiner cites the secondary reference as teaching this missing claim limitation. The secondary reference specifically states that the purpose of the container is to carry water. The Examiner then concludes that it would have been obvious to modify the primary reference with the secondary reference in order to carry water. The Examiner believes that he/she has established a *prima facie* case of obviousness since the Examiner has found a reason to have a container of water. However, the Examiner is completely ignoring the teaching of the primary reference. Why would one skilled in the art modify a plastic gun that shoots darts to have a container of water? This is the key question to answer. While having a container of water may be used to carry water, that is irrelevant as far as the purpose of the primary reference. Simply citing to a passage in the secondary reference that discusses the purpose of that secondary reference may not be sufficient evidence for an obviousness rejection. After all, surely there is a reason as to why the secondary reference teaches the missing claim limitation or else why would it include it? The Examiner must explain the connection between the teachings of the primary reference and the rationale of the secondary reference for including the missing claim limitation. Otherwise, everything can be deemed obvious and virtually nothing can be patented.

§103(a), the reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). The Examiner cites the Svancarek and Talbot references in his rejection of claims 5, 8, 14, 17, 23 and 24 under 35 U.S.C. §103(a). The Talbot reference addresses the problem of providing reverse blind electronic credit auctions providing for financial institution bidding using masked credit reports. [0002]. Appellants, on the other hand, address the problem of managing entitlements associated with packages of services. Specification, page 3, lines 11-27. Hence, the Talbot reference is not in the same field as Appellants' endeavor and is not reasonably pertinent to solving the problem of managing entitlements associated with packages of services. As a result, the Talbot reference is not an analogous prior art and the Examiner has not established a *prima facie* case of obviousness in rejecting claims 5, 8, 14, 17, 23 and 24. M.P.E.P. §2141.01; 2143.01.

C. Claims 7 and 16 are improperly rejected under 35 U.S.C. §103(a) as being unpatentable over Svancarek.

The Examiner has rejected claims 7 and 16 under 35 U.S.C. §103(a) as being unpatentable over Svancarek. Office Action (9/6/2006), page 11. Appellants respectfully traverse for at least the reasons stated below.

1. Improper use of *In re Gulack* and *In re Lowrey*.

The Examiner states:

As analyzed above, Svancarek et al. shows presenting the recipient with alternate content when the recipient is not entitled to the requested service. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the presenting step recited. The data to be displayed when the recipient is found ineligible does not change the function being performed. The presenting of alternate content would be performed in the same manner regardless of the exact composition of the content, whether a message, an alternate website or a description of criteria.

Thus, the non-functional descriptive material will not distinguish the claimed invention from the prior art Svancarek et al. in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowrey*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Office Action (9/6/2006), page 11.

Appellants respectfully traverse the Examiner's use of *In re Gulack* and *In re Lowrey* to support the Examiner's contention that the limitation of claims 7 and 16 can be ignored simply because the Examiner deems the limitations to be non-functional.

In re Gulack and *In re Lowrey* are directed to the situation in which the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine. M.P.E.P. §2106. That is not the case here. As Appellants pointed out, there are numerous limitations in the claimed inventions not taught or suggested in the cited prior art. Consequently, the Examiner's reliance of *In re Gulack* and *In re Lowrey* is improper.

Further, in order to establish a *prima facie* case of obviousness, the Examiner must provide a reference or combination of references that teaches or suggests all of the claim limitations. M.P.E.P. §2143. The Examiner cannot ignore claim language. All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. §2143.03. Since the Examiner has not cited to any passage in Svancarek as teaching the above-cited claim limitation, the Examiner has not established a *prima facie* case of obviousness in rejecting claims 7 and 16. M.P.E.P. §2143.

2. The Examiner's motivation for modifying Svancarek to include the missing claim limitation of claims 7 and 16 is insufficient to establish a *prima facie* case of obviousness.

The Examiner states:

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to present alternate content obtain when the recipient is ineligible for the service regardless of the specific composition of the content, whether a message, an alternate website or a description of criteria, because such content does not functionally relate to presenting step and also because the content to be displayed does not patentably distinguish the claimed invention. Office Action (9/6/2006), page 11.

In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation to modify the reference or to combine reference teachings. See *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner's statement that "because such content does not functionally relate to presenting step and also because the content to be displayed does not patentably distinguish the claimed invention" does not provide objective reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Svancarek to include the missing claim limitations of claims 7 and 16. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 7 and 16. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

VIII. CONCLUSION

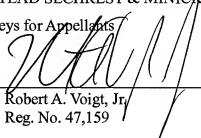
For the reasons noted above, the rejections of claims 1-25 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 1-25.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Appellants

By: _____


Robert A. Voigt, Jr.
Reg. No. 47,159

P.O. Box 50784
Dallas, Texas 75201
(512) 370-2832

CLAIMS APPENDIX

1. A method for entitlement management comprising:
responsive to a request for a service, determining if a recipient identified in said request is entitled to said service;
if said recipient is entitled to said service, delivering said service, wherein
said step of determining if said recipient is entitled to said service comprises:
comparing a set of administrator-configurable package profile attributes values associated with a package of services containing said service with corresponding values for said recipient.
2. The method of claim 1 further comprising if, responsive to said determining step, if said recipient is not entitled, sending a message to said recipient indicating said recipient is not entitled to said service.
3. The method of claim 1 further comprising configuring said set of package attributes wherein said set of package attributes includes selected attributes having one or more attribute values.
4. The method of claim 1 further comprising:
determining if said service includes a limited number of accesses; and
if said service includes a limited number of accesses, decrementing a tracking count associated with the service.
5. The method of claim 1 wherein said substep of comparing a set of package profile attributes values associated with a package of services containing said service with corresponding values for said recipient comprises:
for each profile attribute in said set of profile attributes, determining if a current attribute is single-valued; and
if said current attribute is single-valued, determining said recipient is not entitled if a value of said current attribute and a corresponding value for said recipient miscompare.

6. The method of claim 2 wherein the step of sending said message comprises presenting said recipient with alternate content.
7. The method of claim 6 wherein said alternate content includes a description of criteria for said requested service.
8. The method of claim 5 wherein if said current attribute is not single-valued, determining said recipient is not entitled if each value of said current attribute and a corresponding value for said recipient miscompare.
9. The method of claim 4 further comprising:
 - logging a delivery of said service;
 - decrementing a number of available instances of said service if said service has a limited usage count; and
 - sending a message to said recipient indicating said recipient is not entitled to said service if the limited usage count has been consumed.
10. A computer program product embodied in a tangible storage medium, the program product comprising programming instructions for entitlement management, the programming instructions for:
 - responsive to a request for a service, determining if a recipient identified in said request is entitled to said service;
 - if said recipient is entitled to said service, delivering said service, wherein
 - said programming instructions for determining if said recipient is entitled to said service comprises programming instructions for
 - comparing a set of administrator-configurable package attributes values associated with a package of services containing said service with corresponding values for said recipient.
11. The computer program product of claim 10 further comprising programming instructions for, if, responsive to said determining step, if said recipient is not entitled,

sending a message to said recipient indicating said recipient is not entitled to said service.

12. The computer program product of claim 10 further comprising programming instructions for configuring said set of package attributes wherein said set of package attributes includes selected attributes having one or more attribute values.

13. The computer program product of claim 10 further comprising programming instructions for:

determining if said service includes a limited number of accesses; and

if said service includes a limited number of accesses, decrementing a tracking count associated with the service.

14. The computer program product of claim 10 wherein said programming instructions for comparing a set of profile attributes values associated with a package of services containing said service with corresponding values for said recipient comprise programming instructions for:

for each profile attribute in said set of profile attributes, determining if a current attribute is single-valued; and

if said attribute is single-valued, determining said recipient is not entitled if a value of said current attribute and a corresponding value for said recipient miscompare.

15. The computer program product of claim 11 wherein the programming instruction for sending said message comprises programming instructions for presenting said recipient with alternate content.

16. The computer program product of claim 15 wherein said alternate content includes a description of criteria for said requested service.

17. The computer program product of claim 14 further comprising programming instructions for, if said current attribute is not single-valued, determining said

recipient is not entitled if each value of said current attribute and a corresponding value for said recipient miscompare.

18. The computer program product of claim 13 further comprising programming instructions for:

logging a delivery of said service;

decrementing a number of available instances of said service if said service has a limited usage count; and

sending a message to said recipient indicating said recipient is not entitled to said service. if the limited usage count has been consumed.

19. A data processing system for entitlement management comprising:

circuitry operable for, responsive to a request for a service, determining if a recipient identified in said request is entitled to said service;

if said recipient is entitled to said service, delivering said service, wherein

said programming instructions for determining if said recipient is entitled to said service comprises programming instructions for

comparing a set of administrator-configurable package attributes values associated with a package of services containing said service with corresponding values for said recipient.

20. The data processing system of claim 19 further comprising circuitry operable for, if, responsive to said determining step, if said recipient is not entitled, sending a message to said recipient indicating said recipient is not entitled to said service.

21. The data processing system of claim 19 further comprising circuitry operable for configuring said set of package attributes wherein said set of package attributes includes selected attributes having one or more attribute values.

22. The data processing system of claim 19 further comprising:
circuitry operable for determining if said service includes a limited number of

accesses; and

circuitry operable for, if said service includes a limited number of accesses, decrementing a tracking count associated with the service.

23. The data processing system of claim 19 wherein said circuitry operable for comparing a set of profile attributes values associated with a package of services containing said service with corresponding values for said recipient comprises:

circuitry operable for, for each profile attribute in said set of profile attributes, determining if a current attribute is single-valued; and

circuitry operable for, if said attribute is single-valued, determining said recipient is not entitled if a value of said current attribute and a corresponding value for said recipient miscompare.

24. The data processing system of claim 22 further comprising programming instructions for, if said current attribute is not single-valued, determining said recipient is not entitled if each value of said current attribute and a corresponding value for said recipient miscompare.

25. The data processing system of claim 21 further comprising programming instructions for:

logging a delivery of said service;

decrementing a number of available instances of said service if said service has a limited usage count; and

sending a message to said recipient indicating said recipient is not entitled to said service if the limited usage count has been consumed.

EVIDENCE APPENDIX

No evidence was submitted pursuant to §§1.130, 1.131, or 1.132 of 37 C.F.R. or of any other evidence entered by the Examiner and relied upon by Appellants in the Appeal.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings to the current proceeding.

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